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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,732	03/08/2002	Hiroshi Kajiyama	3620-4014	5009

27123 7590 12/28/2007

MORGAN & FINNEGAN, L.L.P.
3 WORLD FINANCIAL CENTER
NEW YORK, NY 10281-2101

EXAMINER	
JOHNSON, JENNA LEIGH	

ART UNIT	PAPER NUMBER
1794	

NOTIFICATION DATE	DELIVERY MODE
12/28/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOPatentCommunications@Morganfinnegan.com
Shopkins@Morganfinnegan.com
jmedina@Morganfinnegan.com

Office Action Summary	Application No.	Applicant(s)	
	10/018,732	KAJIYAMA ET AL.	
	Examiner	Art Unit	
	Jenna-Leigh Johnson	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 August 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5-7 and 9-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5-7 and 9-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The Amendment submitted on November 9, 2006, has been entered. Claims 1 – 4, 8, and 12 – 77 have been cancelled. Therefore, the pending claims are 5 – 7 and 9 – 11.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 5 – 7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10287753 A in view of Kolstad et al. (6,114,495) for the reasons of record.

4. Claims 9 and 10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10287753 A and Kolstad et al. as applied to claim 5 above, and in further view of Matsui et al. (6,174,602) for the reasons of record.

5. Claim 11 stands rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10287735A and Kolstad et al. as applied to claim 5 above, and in further view of Matsui et al. and *Wellington Sears Handbook of Industrial Textiles* (pages 57 – 60) for the reasons of record.

Response to Arguments

6. Applicant's arguments filed August 27, 2007 have been fully considered but they are not persuasive. The applicant argues that the claimed invention is a result of combining certain materials together, i.e., linear polylactic acid, wherein the polylactic resis has at least 98 mole % of the L-isomer and an inert content of less than 3%, less than 30 ppm of tin, and less than 0.5 wt-% of a residual monomer, to produce the improved properties (response, page 4). Each of these components added to the composition has been addressed by the rejection based on JP 102877735 and Kolstad et al. The applicant argues that Kolstad et al. does not teach having less than 3% of an inert content because Kolstad et al. is silent to the inert compound and the data shows that the yarn size in a longitudinal direction which cannot

be considered to be uniformly linear in structure. First, it cannot be assumed that inert compound is there if it is not mentioned. The applicant must provide evidence which shows it present in an amount greater than 3% to provide support for this argument. Second with regards to the data which shows the yarn size in the longitudinal direction, it is unclear what data the applicant is referring to. Further, it is unclear how the yarn size of relates to the linear structure of the polylactic acid polymer. Without further support and explanation of this statement, it is not sufficient to overcome the rejection.

7. Further, it is noted that rejection is based on a combination of references and the applicant is only addressing a single reference in the rejection. In response to applicant's arguments against the individual reference, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The applicant must address the rejection as a whole and not just a portion of a single reference used to reject the claims.

8. With regards to the applicant's arguments that the prior art fails to recognize the improved properties of the claimed invention, it has been held that as long as there is evidence of record establishing inherency, failure of those skilled in the art to contemporaneously recognize an inherent property, function or ingredient of a prior art reference does not preclude a finding of anticipation. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999). Thus, the prior art does not need to specifically recognize bi-products or properties which are a result of the claimed process or physical structure. Further, it is noted that when the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not. *In re Spada,* 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Thus, the burden has shifted to the Applicant to provide evidence that the properties are not inherent in the prior art materials. *In re Best,* 562 F.2d at 1255, 195 USPQ at 433. Arguments of counsel cannot take the place of evidence. *In re De Blauwe,* 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984). In other words. the

prior art is not required to recognize all properties which are present in the product or process. Therefore, in the absent of specific evidence showing that the combination of references would not have the claimed materials or the claimed properties the rejection will be maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Johnson whose telephone number is (571) 272-1472. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jlj
December 21, 2007

/Jenna-Leigh Johnson/
Primary Examiner
Art Unit 1794